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OFFICE OF PETITIONS

In re Application of :
Meyer et al. :
Application No. 09/633087 :
Filing or 371(c) Date: 08/04/2000 :
Attorney Docket Number: :
(TT3327) : **ON PETITION**

This is a decision on the "Request for Reconsideration of Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," filed August 11, 2008. The petition is properly treated under 37 CFR 1.181(a).

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed June 18, 2007. The Office action set a three (3) month period for reply. No response having been received, the application became abandoned on September 19, 2007. The mailing of this Decision precedes the mailing of a Notice of Abandonment was mailed December 31, 2007.

Applicants filed a petition on January 31, 2008, and stated that the Office action was not received. Applicants provided that it believed the Office action was not received because the Patent Office indicated the wrong correspondence address for this application. Applicants pointed out that a Notice of Change of Correspondence Address was filed on October 5, 2003. However, upon searching the file, Applicants noted from the correspondence received from the U.S. Patent and Trademark Office that Applicants' address had not been changed from previous counsel. Applicants believed that the correspondence may have been sent to the wrong address. Applicants filed a copy of their docket records, and stated that

When an Office action requiring a response is received from the U.S. Patent Office by our office, the due date for responding to the Office action is entered into our computerized docketing system. The information is entered using the Attorney Docket Number identified on the office action. The office action is subsequently routed to and physically placed into the corresponding application file.

Applicant's representative encloses a copy of the docket record corresponding to the above referenced application. If the allegedly mailed Office Action was received, the docket record would indicate a due date for response, the typical response to an Office Action. The enclosed docket record copy does not show an Office Action response due date, thus indicating that the Office Action was not received from the U.S. Patent Office. Applicant's representative has searched the respective file and can find no indication of the allegedly mailed Office action therein.

Review of Office records

A review of Office records reveals that the Office action, along with two previous Office actions, mailed March 30, 2004 and October 20, 2006, respectively, were inadvertently mailed to an incorrect correspondence address. Applicants received, docketed and responded to the prior Office actions; however, Applicants assert that this Office action was not received. Applicants do not explain how it is that the prior Office actions were received, docketed and responded to, over a period of more than two years after the correspondence address had changed. Instead, with the final Office action, Applicant's allege nonreceipt.

March 10, 2008 Decision dismissing the petition

On March 10, 2008, a Decision dismissing the petition was mailed. The Decision noted that a review of Applicants docket records revealed that Applicants received, docketed and responded to previous Office actions, mailed March 30, 2004 and October 20, 2006, respectively. Both Office actions had been mailed well after the Applicant's correspondence address had changed, and in the case of the latter non-final Office action, mailed October 20, 2006, it was mailed more than three years after the correspondence address change was filed. Yet this Office action was received, entered and docketed, and responded to by Applicant, including a one-month extension of time request and fee. Applicants took no issue with the mailing of the Office action to an incorrect mailing address. Applicants did not assert at that time, that the Office action was mailed to an incorrect correspondence address, possibly costing Applicant time in preparing and filing a response. Instead, Applicants paid the extension of time fee in order to render the reply, filed February 23, 2007, timely, without comment on the mailing of the Office action to an incorrect correspondence address.

The Decision noted that only with the mailing of the final Office action, did Applicant attempt to rely upon the non-entered change of correspondence address to support a re-mailing of the Office action and a resetting of the period for reply. In view of Applicants' reliance upon the docketing system as evidence that the final Office action, mailed to the previous correspondence address, was not received, and in view of evidence that the receipt of two previous Office actions, mailed March 30, 2004 and October 20, 2006, respectively, both of which were mailed to the previous

correspondence address, yet received by and responded to by Applicant, there was a question of whether the final Office action may have been lost after receipt.

The petition was dismissed without prejudice

The present request for reconsideration

Applicants file the present request for reconsideration and provide that the previous Law Firm, Fletcher Yoder, forwarded both the prior Office actions; however, did not forward the final Office action. Applicants reiterate that this Office did not change the correspondence address.

Office records

1. Assignment records

A further review of Office records reveals that in the oath/declaration filed with the application on August 4, 2000, the inventors appointed the attorneys of Advanced Micro Devices, Inc, AND the law firm of Fletcher, Yoder & Van Someren, jointly, and each of them severally, attorneys, with full power of substitution, delegation and revocation, to prosecute the application.

A review of Office assignment records reveals that the inventors also executed assignments recorded in this Office on August 4, 2000. Two inventors assigned their interests in the present application to Aplha Processor Inc., and two inventors assigned their interests in the present application to Advanced Micro Devices, Inc. Thereafter Office assignment records reveal that API Networks, Inc., assigned their interest in the present application to Samsung Electronics Co., LTD. Office records do not reveal how API Networks, Inc., obtained an interest in the application.

2. Change of Correspondence Address

A review of the Notice of Change of Address filed October 3, 2008 reveals that it was executed by the Assistant Secretary of Advanced Micro Devices, Inc., only.

Applicable Law, Rules and MPEP

37 CFR 1.33, Correspondence respecting patent applications, reexamination proceedings, and other proceedings, provides in (b)(2)

Where a § 1.63 oath or declaration has been filed by any of the inventors. If a § 1.63 oath or declaration has been filed, or is filed concurrent with the filing of an application, by any of the inventors, the correspondence address may be changed by the parties set forth in paragraph (b) of this section, except for paragraph (b)(2).

(b) Amendments and other papers . Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

- (1) A patent practitioner of record appointed in compliance with § 1.32(b);
- (2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;
- (3) An assignee as provided for under § 3.71(b) of this chapter; or
- (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

The MPEP 601.03 provides:

Where a correspondence address has been established on filing of the application or changed pursuant to 37 CFR 1.33(a)(1) (prior to the filing of an executed oath or declaration under 37 CFR 1.63 by any of the inventors), that correspondence address remains in effect upon filing of an executed oath or declaration under 37 CFR 1.63 and can only be subsequently changed pursuant to 37 CFR 1.33(a)(2). Under 37 CFR 1.33(a)(2), where an executed oath or declaration under 37 CFR 1.63 has been filed by any of the inventors, the correspondence address may be changed by (A) a patent practitioner of record, (B) an assignee as provided for under 37 CFR 3.71(b), or (C) all of the applicants (37 CFR 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with 37 CFR 3.71. See 37 CFR 1.33(a)(2).

37 CFR 3.71(b), Patents — assignee(s) who can prosecute, states

The assignee(s) who may conduct either the prosecution of a national application for patent or a reexamination proceeding are:

- (1) A single assignee . An assignee of the entire right, title and interest in the application or patent being reexamined who is of record, or
- (2) Partial assignee(s) together or with inventor(s) . All partial assignees, or all partial assignees and inventors who have not assigned their right, title and interest in the application or patent being reexamined, who together own the entire right, title and interest in the application or patent being reexamined. A partial assignee is any assignee of record having less than the entire right, title and interest in the application or patent being reexamined. (Emphasis supplied).

The MPEP 711.03(c)A, Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action, provides

In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue

fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions). (Emphasis supplied)

MPEP 711.03(c)

Analysis

In this instance, the correspondence address change filed October 8, 2003 was executed by the Assistant Secretary of Advanced Micro Devices, Inc., only. At the time the correspondence address change was filed, Advanced Micro Devices, Inc., was a partial assignee, and not the owner of the entire right, title and interest in the application. As stated in the MPEP 601.03, the correspondence address could only be subsequently changed pursuant to 37 CFR 1.33(a)(2). The change of correspondence address executed by the partial assignee failed to comply with 37 CFR 1.33(b)(2), and was thuswas ineffective to change the correspondence address.

Conclusion

The petition is dismissed. Applicants may file a request for reconsideration. After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply any and all relevant information and documentation with his request for reconsideration. The Director's decision will be based solely on the administrative record in existence.

Alternate venue

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the

date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Director for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
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